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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,823	12/29/2005	Tadashi Asanuma	003510-160	5832

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EXAMINER

MCPHILLIP, ADRIAN J

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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11/13/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/562,823	Applicant(s) ASANUMA ET AL.	
	Examiner Adrian J. McPhillip	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20051229</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a non-final, first office action on the merits. Claims 1-10 are pending.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. For example, the following items are not understood:

(A) Page 1 of the specification discloses: *managing the procedure of an office work*

capable of saving a corporation or the like the trouble of managing the procedure of the office work and performing a reasonable procedure of the office work by collectively managing a submit period of documents and an answer to an administrative organ.

(B) Page 4 of the specification discloses: *starts the period management of corresponding*

action of acquiring documents or something by inputting the information of the acquiring documents or something from the administrative organ to the period

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management system, and transmits period management information and the information of the documents or something to the client.

(C) Page 5 of the specification discloses: *acquiring documents or something from the administrative organ to the period management system, and transmits period management information and the information of the documents or something to the client by an information delivering unit, and always provides to only the clients the information stored in the period managing system by the period managing system using web site.*

The items mentioned above are not an exhaustive list. The disclosure as a whole precludes a reasonable search of the prior art because it cannot be well understood by the Examiner.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms, which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: *documents or something* (see lists above).

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Claim Objections

5. Claims 1-10 are objected to under 37 CFR 1.75(c).
6. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

7. Furthermore, where a claim sets forth a plurality of elements or steps, as in claims 1-2 and 7-8, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i). There may be plural indentations to further segregate subcombinations or related steps (see MPEP 608.01(m)).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-10 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

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Furthermore, the structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete, operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

10. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Regarding claims 1-10, the phrase "or something" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "something"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Furthermore repeated usage of the term "and/or" renders the respective claims indefinite because it does not make clear the scope of Applicant's claimed invention. Whether Applicant intends to claim the inclusive "and", the alternative "or", or both, the Examiner is uncertain. Appropriate correction is required to place the claims in definite form and clearly point out that which Applicant claims as his/her invention.

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 2, 4, 6, 8 and 10 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2)

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transform underlying subject matter (such as an article or materials) to a different state or thing.

Diamond v. Diehr, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

14. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be preformed without the use of a particular apparatus. Thus, claims 2, 4, 6, 8 and 10 are non-statutory.

15. Claims 1, 3, 5, 7 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite numerous limitations including and directed to, "administrative organs" which according to the specification mean, "agent(s) of the government office" (see **page 5**). MPEP 2105 issues the following guidelines to Examiners in the determination of whether an invention is statutory, "If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter." In this case "administrative organs" are in fact human beings and as such claims 1, 3, 5, 7 and 9 are non-statutory.

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16. In light of the 112 and 101 rejections above, Examiner respectfully submits that the prior art has been applied to the claimed invention as best understood.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Grow et al (US 6694315 B1 - hereafter Grow).

Regarding **claims 1-2**, Grow discloses an online docketing system that allows users to exchange documents over the Internet (see **fig 1 & col. 1**). The system comprises means for associating deadlines or time periods (with the documents being exchanged as well as encryption software for limiting access to the documents in question (see **col. 19**).

Regarding **claims 3-4**, Grow discloses means for managing how documents are docketed to the appropriate person (see **col. 4**).

Regarding **claims 5-6**, Grow discloses means for determining the items needed for managing the procedure of the office work such as procedures to be managed, items to be managed at every procedure, and methods of the management, in advance (see **col. 5-6** wherein the docket field contains information relevant to the processing of the document in question).

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Regarding **claims 7-8**, Grow discloses means for transmitting data between clients (see **col. 6**).

Regarding **claims 9-10**, Grow discloses means for completing the docketed documents and submitting them to the appropriate parties (see **col. 6, lines 51-67** wherein assembled documents are downloaded or otherwise transmitted to the user workstation where it can be edited, stored, completed and ultimately retransmitted either back to server or to the appropriate party.)

Conclusion

19. **Examiner's Note:** Examiner has cited particular paragraphs and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrian J. McPhillip whose telephone number is (571)270-5399. The examiner can normally be reached on Monday to Thursday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571)272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. J. M./

Examiner, Art Unit 3623

11/5/2008

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623